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| APPLICATION NO.      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------|-------------|----------------------|---------------------|------------------|
| 10/082,069           | 02/26/2002  | Dwight A. Merriman   | 11032/3040          | 8044             |
| 23838                | 7590        | 11/16/2007           | EXAMINER            |                  |
| KENYON & KENYON LLP  |             |                      | CHAMPAGNE, DONALD   |                  |
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| SUITE 700            |             |                      |                     |                  |
| WASHINGTON, DC 20005 |             |                      |                     |                  |
|                      |             |                      | ART UNIT            | PAPER NUMBER     |
|                      |             |                      | 3622                |                  |
|                      |             |                      | MAIL DATE           | DELIVERY MODE    |
|                      |             |                      | 11/16/2007          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                 |                                 |  |
|------------------------------|---------------------------------|---------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/082,069   | Applicant(s)<br>MERRIMAN ET AL. |  |
|                              | Examiner<br>Donald L. Champagne | Art Unit<br>3622                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20 sheets</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statements filed 26 February 2002 and 14 August 2006 are enclosed and have been certified as to the cited patent documents. However, the 14 August 2006 IDS fails to comply with the provisions of 37 CFR 1.98(b)(5) for the non-patent literature, so these items have neither been considered nor certified.
2. Each NPL item is identified in the list with a number, e.g., "17625888" for the first item on p. 7 of 18. However, these ID numbers do not appear on the documents, so the document is not identified. To be acceptable, the listing and the documents must be coordinated. In addition, each NPL item must be identified as to source, as required by 37 CFR 1.98(b)(5).
3. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections in the information disclosure statement. **NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b).** Failure to timely comply with this notice will result in the above mentioned information disclosure statement being placed in the application file with the noncomplying information **not** being considered. See 37 CFR 1.97(i).

### **Claim Rejections - 35 USC § 102 and 35 USC § 103**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 5-11, 18-20, 23-29, 36-38, 41-47, 54 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Roth et al. (US006285987B1).
7. Roth et al. teaches (independent claims 1, 19, 37 and 55) a method, system and computer readable medium for online re-targeted advertisement selection, the method comprising:
  - (a) receiving feedback on prior activities of a user at an advertiser Web site (col. 4 lines 44-49);
  - (b) receiving a request to display advertising content to the user (col. 4 lines 58-61); and
  - (c) selecting, in response to the request, advertising content for display based upon the received feedback on prior activities of the user at the advertiser Web site (col. 2 lines 11-31 and 31-37).
8. Roth et al. teaches at the citations given above claims 7, 25 and 43.
9. Roth et al. teaches: claims 2, 20 and 38 (col. 5 lines 24-27); claims 5, 23 and 41 (col. 5 lines 20-23, where a *HTML* reference reads on "a tag"); claims 6, 24 and 42 (col. 19 lines 24-33, where *ISP 712* reads on "a proxy server"); claims 8, 26 and 44 (col. 8 lines 65-67); claims 9, 27 and 45 (col. 18 lines 46-48); claims 10, 11, 28, 29, 46 and 47 (col. 7 lines 34-38 and Fig. 3, elements 16A and 16B, and Fig. 4); and claims 18, 36 and 54 (front page, "article by Toland").
10. Claims 3, 4, 12-17, 21, 22, 30-35, 39-40, and 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. (US006285987B1).
11. Roth et al. does not teach that: feedback is received by email or FTP message (claims 2, 4, 21, 22, 39 and 40); the re-targeted ad is a coupon when the user visited the web site but did not purchase the product (claims 12, 13, 30, 31, 48 and 49); the re-targeted ad is a reminder when the user made previous but not recent purchases (claims 14, 15, 32, 33, 50 and 51); and the re-targeted ad is best-customer thank you when the user made purchases at some minimum rate (claims 16, 17, 34, 35, 52 and 53). Roth et al. does teach acquiring data on frequency of site visit and purchases (col. 2 lines 37-41, col. 4 lines 11-15, col. 4 line 63 to col. 5 line 5 line 8, col. 8 lines 53-55 and 65-67, and col. 9 lines 57-58).

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12. Official notice of this common knowledge or fact well known in the art was taken in the last Office action (mailed 6 April 2007, para. 8). Since applicant failed to traverse the examiner's assertion, it is taken to be admitted prior art (MPEP 2144.03.C).

***Response to Arguments***

13. Applicant's arguments filed with an amendment on 6 September 2007 have been fully considered but they are not persuasive.

14. Applicant argues,

"Specifically, Roth does not use the characteristics of the viewer to select the advertisement; the viewer characteristics are only used to solicit bids from advertisers, not to select the bid to be shown to a user." (pp. 2-3, emphasis added.)

The characteristics of the viewer (Roth et al., col. 2 line 16) are used by advertisers to form bids (col. 2 lines 11-31 and 37-41), and those bids are used to select the ad to be shown (col. 2 lines 7-10). In formal logic, "C" (characteristics of the viewer) determines "B" (the advertiser bids), and "B" determines "A" (the ad to be shown to the viewer). (See also col. 2 lines 54-60.) It follows logically that "C" (characteristics of the viewer) determines "A" (the ad to be shown to the viewer), which reads on the claims.

15. Applicant argues (p. 3 of 4) that the taking of official notice is not supported by evidence, especially for claim 15. However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on alleged evidence, not mere denial. Applicant could, for example, have done a search to establish that it is not common for ads specifying a website to be on a reminder or thank-you note. The examiner would then have been compelled to produce references in order to maintain the taking of official notice. But applicant submitted no such evidence. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.
16. In response to applicant's specific question concerning the rejection of claim 15, anything that promotes, including the name of an advertiser or a product, reads on "advertising". It is obvious to mention the advertiser or product, as well as the advertiser's address (web site) in a reminder or thank-you note.

**Conclusion**

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
20. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
22. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words.

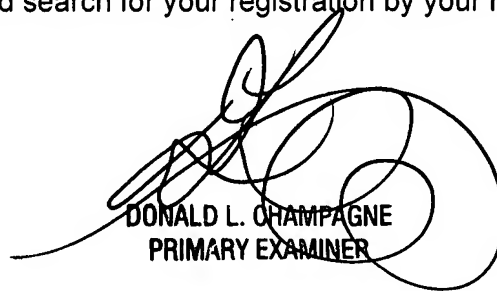
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Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

23. Applicant may have after final arguments considered and amendments entered by filing an RCE.

24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

8 November 2007



DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622